

REMARKS

Claims 2, 3, 12, 23 and 24 are now active in this application. The indication that claims 12, 23 and 24 are allowable is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

Claims 2 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cima et al. (USPN 5,387,380). The Examiner contends that “the use of one material that becomes stable faster than another material before the another material is applied to the layer” amounts to an intended use of the apparatus and has no patentable weight.

The rejections are respectfully traversed.

Claim 2 requires, *inter alia*:

controlling said applying head *by said controller to apply said plural kinds of material selectively to a predetermined region on said layer includes* applying a first material included in said plural kinds of materials and having a first time for becoming stable, after application of a second material included in said plural kinds of materials and having a second time for becoming stable, less than the first time.

Claim 3 requires, *inter alia*:

controlling said applying head *by said controller to apply said plural kinds of materials selectively to a predetermined region on said layer includes* applying said binder after applying said ink.

Thus, both claims 2 and 3 are limiting the controlling by the controller to the specifically recited control function(s)/operations. As stated in M.P.E.P. § 2173.05(b), a functional

limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

As stated further in M.P.E.P. § 2173.05(b), functional limitation *must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used*. Thus, the apparatus recited in claims 2 and 3 is distinguishable over prior art apparatus by at least the specifically recited “controlling” by the controller of the applying head. More specifically, in claim 2, controlling by the controller of the applying head (for applying plural kinds of materials to the layers) includes applying a first material included in the plural kinds of materials and having a first time for becoming stable, after application of a second material included in the plural kinds of materials and having a second time for becoming stable, less than the first time. Similarly, in claim 3, controlling by the controller of the applying head (for applying plural kinds of materials to the layers) includes applying the binder after applying the ink.

The recited apparatus having a controller performing these particular control functions is distinguish from similar apparatus having controller that does **NOT** perform these particular control functions. In this regard, the present situation is similar to a combination, which includes a computer having a stored program directing the carrying out of specific function(s), being patentably distinct from a similar combination, which includes a computer having a store program directing the carrying out of different specific function(s). Current case law regarding

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such combination surely leaves no doubt that such combination, with a computer having a stored program directing specific functions, is both patentable and distinct from a similar combination, with a computer having a stored program directing different specific functions.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Clearly, the controlling operations/functions of claims 2 and 3 are neither disclosed nor suggested in Cima et al. Thus, claims 2 and 3 are patentable over Cima et al. and their allowance is respectfully solicited.

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CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over a horizontal line.

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